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SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 850040001

EXAMINER

WALSH, DANIEL I

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Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/708,828	Applicant(s) BEENAU ET AL.	
	Examiner Daniel I. Walsh	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-04, 4-04, 8-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 26 March 2004, 9 April 2004, and 20 August 2004.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No.

10/710,317. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn towards contactless communication of data. Though the current application is drawn towards a transponder and the '317 Application is drawn towards smart card, both types of media are recognized as obvious and conventional types of media for communicating. Therefore, such modification is well within the skill in the art, especially as prior art discloses transponders and smart cards being interchangeable.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

I) For example, in claim 1 of the present Patent Application the Applicants claim: "... transponder... reader... signature scan sample... verify... facilitate a transaction." (see claim 1), whereas in the '317 Patent Application the Applicants claim: "... smartcard... reader... signature scan sample... verify... facilitate a transaction." (see claim 1).

II) For example, in claim 22 of the present Patent Application the Applicants claim: "... transponder... signature scan... verification... authorization of a transaction." (see claim 22), whereas in the '317 Patent Application the Applicants claim: "... smartcard... signature scan... verification... authorization of a transaction." (see claim 22).

III) For example, in claim 34 of the present Patent Application the Applicants claim: "... transponder... signature scan... verifying... authorizing..." (see claim 34), whereas in the '317 Patent Application the Applicants claim: "... smartcard... signature scan... verifying... authorizing..." (see claim 34).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 11, 13-15, 20, 22-24, 26, 28, 34, 35, 37-39, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Black (US 2005/0122209).

Re claim 1, Black teaches a transponder configured to communicate with a reader, a reader configured to communicate with the system, a signature scan sensor configured to detect a proffered signature scan sample, the signature scan sensor configured to communicate with the system, and a device configured to verify the proffered signature scan sample to facilitate a transaction (abstract and FIG. 1A).

Re claim 2, the sensor is configured to communicate with the system via at least one of a transponder, reader, and network (FIG. 1A).

Re claim 3, the signature scan sensor is configured to facilitate a finite number of scans (namely one).

Re claim 4, Black teaches the sensor is configured to log at least one of a detected scan sample, processed scan sample, and stored scan sample (FIG. 5A+, paragraph [0125], and FIG. 10A+).

Re claim 11, the proffered signature is compared to a stored to verify the signatures, as discussed above.

Re claim 13, as the sample is stored, its interpreted as registered.

Re claim 14, Black teaches that a customer's account is linked to the biometric/signature data and can be used for payment and is linked to a credit or debit account (col 6, lines 46+ and abstract).

Re claim 15, the system of Black can be used by numerous individuals, who inherently have different information.

Re claim 20, it has been discussed above that the device facilitates a financial transaction.

Re claim 22, Black teaches proffering a signature scan to a signature scan sensor communicating with the system to initiate verification of a signature scan sample for facilitating authorization of a transaction (abstract, FIG. 1A, and as discussed above).

Re claim 23, the Examiner has interpreted the storing of the signature scan sample as it being registered with an authorized sample receiver.

Re claim 24, the Examiner notes that registering includes proffering the same (abstract, FIG. 5A, as discussed above).

Re claim 26, the Examiner notes that proffering includes initiating at least one of storing, comparing, and verifying the sample, as discussed above.

Re claim 28, it has been discussed above that the proffered sample is compared with a stored sample.

Re claim 34, the limitations have been discussed above.

Re claim 35, Black teaches that the sample is detected at a sensor configured to communicate with the system via one of a transponder/reader/network (FIG. 1A-1C).

Re claim 37, it has been discussed above that the sample is detected/stored/processed (abstract).

Re claim 38, the limitations have been discussed above re claim 3.

Re claim 39, Black teaches logging each sample by a transaction record (paragraph [0125]).

Re claim 42, the limitations have been discussed above re claim 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 5-9, 12, 19, 21, 25, 27, 29, 30, 32, 33, 36, 40, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above.

Re claims 5-6 and 44 Black teaches (col 6, lines 56+) that the customer record can be stored locally or remotely. Though silent to a datapacket stored on a database, Black teaches the customer record can include biometric information, user information, etc. (FIG. 5A+ for example), which is interpreted as a datapacket. It would have been obvious to store such information on a database, in order to have a well known and conventional means of storing data for retrieval and organization. It would have been obvious to store the data remotely (or locally) based on security needs, as recognized in the art.

Re claim 7, it has been discussed above that samples are received and stored for providing security/authentication. It would have been obvious to one of ordinary skill in the art that such samples would be received by an authorized sample receiver in order to ensure security and reliability.

Re claims 8 and 36, though silent to a LCD screen or digitizing tablet, Black teaches a digital surface (FIG. 1A). Therefore, it would have been obvious to use a specific type of digital surface (LCD/tablet), as a well known and conventional means of capturing a signature accurately and easily.

Re claim 9, though silent to verifying at least one of shape, speed, stroke, stylus pressure, and timing information, the Examiner notes that at least one of such means (shape for example) are well known and conventional means for matching signatures. One would have been motivated to use such techniques to compare and match/authenticate signatures.

Re claim 12, it has been discussed above that a comparison is performed. The Examiner notes that it would have been obvious to one of ordinary skill in the art to use a microprocessor/controller/processor (interpreted as a protocol/sequence controller) to

electronically perform the comparison, in order to have an electronic (automated) means to quickly and reliably perform the comparison, as is conventional in the art.

Re claim 19, though Black is silent to the sensor providing notification upon detection of a sample, the Examiner notes it is well within the skill in the art to provide such notification in order to inform the user that the sample is received/being processed, as a means to inform the user. As Black indicates when a sample has been authorized (transaction allowed), it would have been obvious to indicate when a sample is read/detected as a means to guide the user through the transaction. Additionally, the Examiner notes that the mere authorization of a transaction can be broadly interpreted as providing notification upon detection of a sample because authorization cannot occur unless the sample was detected. Additionally, the Examiner notes that providing guidance to users involved in a transaction is an obvious expedient, well within the ordinary skill in the art.

Re claims 21 and 33, though silent to secondary security procedures, the Examiner notes that such procedures (PIN, codes, passwords, etc) are all well known and conventional in the art for increased security. One would have been motivated to use such procedures for increased security. Additionally, the Examiner notes that the verification of the biometric samples of Black (separate from the signature sample), such as fingerprints, is also interpreted as a secondary security procedure.

Re claim 25, the limitations have been discussed above re claim 8.

Re claim 27, the limitations have been discussed above re claim 6. The Examiner notes that a database is an obvious expedient, and that processing such information contained in at

least the transponder/reader/sensor/server/reader system is an obvious expedient to reliably authenticate a user during the attempted transaction.

Re claim 29, the Examiner notes that Black teaches (FIG. 4A) that a registration processor and print processor are used. As discussed above, it would have been obvious to one of ordinary skill in the art to use a processor/protocol/sequence controller in order to provide an electronic/automated/reliably means to accurately verify a sample, as is conventional in the art (see claim 12).

Re claim 30 the limitations have been discussed above re claim 9.

Re claim 32, though Black is silent to second proffered signature samples, the Examiner notes that it would have be obvious to one of ordinary skill in the art that the method/system of the present invention would apply to multiple users, and as such, would obvious include multiple proffered samples (first, second, third, etc., depending on the number of unique users).

Re claim 40, the Examiner notes that it would have been obvious to one of ordinary skill in the art to log the samples at least temporarily, in order for them to be verified (stored in a buffer for example during comparison). Additionally, the examiner notes that storing/logging the signatures associated with a transaction (more permanently then in a buffer) are well known and conventional in the art for recording keeping purposes (also see paragraph [0125] which teaches a transaction record).

Re claim 43, the limitations have been discussed above re claim 9.

Re claim 45, the Examiner notes that verifying the sample using information contained on one of a local database/remote database/third party controlled database would have been an obvious expedient in instances where the data is stored remote from the transponder, as

discussed above, for security concerns. A remote database provides a preferred means to organize data for efficient and easy storage and retrieval, and is conventional in the art.

Re claim 46, the limitations have been discussed above re claim 12.

6. Claims 15, 32, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Martizen et al. (US 2002/0191816).

Re claims 15, 32, and 40 the teachings of Black have been discussed above.

Black is silent to different samples (of the same person) associated with a different one of personal information, credit card information, etc.

Martizen et al. teaches different biometric samples associated with different personal information (different fingers with different accounts) (FIG. 6A). The Examiner notes that the signature (as claimed) is interpreted as a biometric.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Martizen et al.

One would have been motivated to do this in order to permit multiple accounts to be accessed with personalized security.

Though Martizen et al. is drawn towards different fingerprints, the Examiner maintains that it is well known and conventional in the art that different biometrics can be used to control access (voice, fingerprints, retina scans, signatures, etc). Accordingly, the Examiner believes that Martizen can be relied upon for the teachings of different samples to control access, where the type of biometric sample chosen, would have been obvious to one of ordinary skill in the art, given that there are numerous recognized and interchangeable biometrics that are accepted to control access.

7. Claims 10, 31, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Black (US 6,307,956).

Re claims 10, and 31, and 41, the teachings of Black have been discussed above.

Black is silent to detecting and verifying false signature devices and thermal patterns.

Black teaches that as part of identity verification, additional sensors to monitor finger temperatures and position of the index finger can be used to authenticate an individual (col 19, lines 57+). This is interpreted as detecting/verifying signatures through thermal/temperature patterns, and is believed to include detecting false signature devices/false signatures in as much is disclosed by the specification.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Black '956.

One would have been motivated to do this for increased security.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Martizen et al., as discussed above, in view of Moebs et al. (US 2005/0065872).

Re claim 16, the teachings of Black/Martizen et al. have been discussed above.

Martizen et al. teaches a biometric sample is associated with at least one of a first user account, wherein the first account comprises personal information, credit card information, etc. and the first account is different than the second account (different samples), but it silent to primary and secondary associating.

Moebs et al. teaches that a customer can avoid overdraft by preauthorized the institution to tie the customers checking account into the other accounts (paragraph [0017]). The Examiner notes that such protection is well known in the art, and is interpreted to include primary and

secondary associating. It would be obvious for the accounts to have the information in order to keep track and identify them.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Martizen et al. with those of Moebs et al.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Teicher et al. (US 6,257,486).

Re claim 17, the teachings of Black have been discussed above.

Black is silent to mutual authentication upon verification of the proffered signature scan sample.

The Examiner notes that mutual authentication is well known and conventional in the art, as a security measure.

It would have been obvious to one of ordinary skill in the art to authenticate upon verification of a sample, as a means to ensure security. Specifically, Teicher et al. teaches mutual authentication being completed between a reader and a card for security (col 7, lines 35+).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Teicher et al.

One would have been motivated to do this in order to employ well-known security measures.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Goodman (US 2002/0043566).

Re claim 18, the teachings of Black have been discussed above.

Black is silent to deactivation of the transponder when the signature sample is rejected.

Goodman teaches deactivation of a card if a predetermined amount of failed PIN attempts are detected (paragraph [0029]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Goodman et al.

One would have been motivated to do this in order to increase system security. For example, if a person attempting to illegally use the transponder was unable to correctly sign (match the stored signature), disabling the transponder would provide security for the rightful owner, while still permitting them to make a mistake themselves without their device being disabled.

Additional Remarks

11. The Examiner notes that there are numerous art recognized biometric means of identification (signature, fingerprint, retinal scan, voice print, DNA, etc.). The Examiner believes it is obvious to one of ordinary skill in the art that the teachings of above cited biometric security references in reference to different types of biometrics could be applied to the specific biometric of signatures, as means to provide biometric security for users. The fact that a reference may disclose a particular type of biometric being used does not preclude such teachings as being non-obvious when used with a different type of biometric, as interpreted by the Examiner.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: McConnell et al. (US 6,148,093), Haala (US 6,934,861), Nakajima et al. (US 2002/0108062), Houvener et al. (US 2002/0138351), Kocher (US 2004/0017934), Haala (US 2005/0005172 and 2005/0102524), Black (US 2005/0180618 and 6,925,565), Doyle (US 2003/0159044), Teicher et al. (US 6,257,620), and Hoshino (US 6,636,620).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
1-5-06

